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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,337	06/27/2001	Daniel W. Doll	1082-503	1137

7590 02/04/2004

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EXAMINER
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MILLER, EDWARD A

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/893,337

Applicant(s)

DOLL ET AL.

Examiner

Edward A. Miller

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see next page.

3. ☒ Applicant's reply has overcome the following rejection(s): obviousness type double patenting.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-32 and 34-44.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6.
10. ☐ Other: \_\_\_\_\_

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1. The amendment filed December 23, 2003 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered for the following reasons.
2. There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
3. The proposed amendment raises new issues that would require further consideration and/or search. These include that, as the claims are proposed to be amended, claims 1 and 15, e.g., would appear to be duplicates of each other and thus require or be subject to a new rejection under 35 USC 101 for duplicate claiming. Further, the cancellation of the phrase "remeltable to a pourable state" requires reexamination and raises issues of new matter under 35 USC 112. Cancellation of this term makes the claims broader, and may imply that the binder may be curable, whereby it would not be "remeltable," which interpretation is broader, would require reexamination, and which may be new matter. At least, applicants have not pointed out basis for the proposed new language. These are exemplary of the reasons relating to requiring reexamination.
4. The terminal disclaimers filed on December 23, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of both US Pat. No. 6,648,998 and application SN 09/893,336 have been reviewed and is accepted.
5. Applicants request that the finality of the final rejection mailed November 06, 2003 be withdrawn in view of an alleged new rejection not necessitated by applicants' amendments. Applicants discuss the July 28, 2003 amendments that were alleged to relate to typo or spelling or antecedent basis problems. The July 28, 2003 amendments were subsequent to Office actions mailed June 27, 2003 and April 08, 2003, which related to restriction matters. In the amendment filed January 21, 2003, applicants responded to the first action rejection mailed October 10, 2002.

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Applicants remarks are not persuasive. The relevant amendments are all the amendments submitted subsequent to the October 2002 rejection, specifically including the January 2003 amendment, as the actions in April and June, as set forth above, were not rejections but related to election or restriction matters. In the amendment of January 21, 2003, applicants cancelled the single claim with 95%, claim 33, and inserted this limitation into all the claims by inserting it into all independent claims.

Further, applicants presented arguments in that January 2003 reply which argued the requirement for at least 95% of certain ingredients. Had this amendment not been submitted, along with the applicants' arguments relating to the meaning of the claim language, the new rejection would not have been made. In any number of applications over many years, numerous applicants have defined a set of main ingredients as adding up to 100%, e.g., while certain other minor ingredients could be added and were recited in amounts such as 10% or 20% added to the 100% of the base or main composition. Thus, applicants' arguments were regarded as a limitation on the content of the claims, to preclude this interpretation of permitting over 100% total of ingredients. When viewed as such, in view of the arguments, the claims were newly regarded as indefinite. The scope of the claim language "comprising," which case law states permits the addition of major amounts of ingredients, newly appeared inconsistent with claim language, particularly as argued, to require at most 5% of other ingredients, or said otherwise, mandating at least 95% of the binder and oxidizer. Thus, applicants' reliance on only the July 28, 2003 amendment is defective, and viewed properly, in view of all the relevant amendments and in view of the new arguments interpreting the claims as to a strict 95% meaning, the rejection newly made on final action is proper, as resulting from applicants' amendments, and from arguments which modified the meaning of the claims.

6. The blank copy submitted December 23, 2003, of the forms 1449 originally submitted in May 2002, has been initialed to correct a minor omission. The references were considered at that

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time, as shown by the fact that the form was originally stamped, although initials were inadvertently omitted, and by the fact that references cited by applicants were used in the prior art rejection, and which were not cited on the form PTO-892 attached thereto.

7. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em  
February 2, 2004



EDWARD A. MILLER  
PRIMARY EXAMINER